REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Status of Claims

Claims 1-18 are pending for examination. Claims 1 and 2 are independent.

Drawings

Submitted herewith are formal drawings in connection with the instant application. Fig. 17 is a formal drawing replacement sheet which is modified from the original Fig. 17 as filed. In the replacement sheet Fig. 17, a "NO" path has been added from the decision block 92 to the line adjacent and on the right of decision block 92. Further, the path from decision block 92 to block 94 has been labeled "YES".

Title of the Invention

Applicant has amended the title of the invention in accordance with the suggestions made by the examiner.

Objections to the Specifications

Applicant has amended the specification in accordance with the suggestions made by the examiner in paragraph 5 of the outstanding Office Action. Further, applicant has reviewed the entire specification and has made additional changes thereto in order to correct minor errors noted therein. No new matter has been added.

Claim Objections

Application has amended the claims in accordance with the suggestions made by the examiner in paragraphs 6-8 of the outstanding Office Action. Further, applicant has amended other portions of the claims in order to clarify the recitations of applicant's invention.

Rejections Under § 112

Claim 2 stands rejected under 35 U.S.C. § 112, second paragraph. The examiner indicates that the recitation of "the document" in steps b and c of claim 2 as insufficient

antecedent basis. By way of the instant amendment, the term "document" in steps b and c of claim 2 has been changed to the plural so that it reads "documents". It is submitted that all of applicant's claims clearly define applicant's invention and comply with the provisions of 35 U.S.C. § 112.

Prior Art Rejections

Claims 1 and 17 stand rejected under 35 U.S.C. § 103 as unpatentable over Catapult in view of Jaakkola. Further, claims 2-3, 5-6 and 11-12 stand rejected under 35 U.S.C. § 103 as unpatentable over Catapult in view of Microsoft Corporation ("User's Guide: Microsoft Word") and further in view of Jaakkola and further in view of Hahn. Claim 4 stands rejected under 35 U.S.C. § 103 as unpatentable over Catapult in view of Microsoft Corporation and further in view of Jaakkola and Hahn and Hikida (5,737,737). Claims 7 and 9-10 stand rejected under 35 U.S.C. § 103 as unpatentable over Catapult in view of Microsoft Corporation and further in view of Jaakkola, Hahn and Parry (6,077,085). Finally, claims 8 and 13-16 stand rejected under 35 U.S.C. § 103 as unpatentable over Catapult in view of Microsoft Corporation and further in view of Jaakkola, Hahn and Costales.

The examiner's rejections are respectfully traversed.

The Examiner cites Catapult, and argues that it discloses, on pages 197-198, Microsoft Word 97' capability to simultaneously acquire and edit multiple structured documents (Microsoft Word documents are inherently structured documents), and this capability constitutes a method of editing a plurality of structured documents, . . .

However, Catapult, on pages 197-198, in fact discloses how to create, using Microsoft Word, a merged document which is a form letter in which customized information is combined with repetitive or boilerplate text, thereby to create many letters efficiently. The letters referred to in Catapult are in no way "structured documents".

The present invention is directed to the extraction of plural elements contained in the structured documents which are acquired into the document edit system shown in Fig. 10 (for example). Since Catapult merely discloses the merge of non-structured documents such as letters, it is clear that Catapult is irrelevant to the present invention claimed in claim 1.

On the other hand, Jaakkola discloses "sgrep" which is <u>a tool for searching test files and filtering text streams</u> using structural criteria The "sgrep" uses patterns called <u>region expressions</u> to express which regions of the input text are output to standard output The Examiner argues that Jaakkola shows, on page 10, examples of the usage of sgrep which indicate that it can be used in a flexible manner that using an <u>element edit statement</u> which indicates an <u>element</u> to be extracted. However, in this regard, the Examiner is not correct in that that Jaakkola merely describes, on page 10, several <u>examples of region expressions</u>, and neither teaches or suggests "an element edit statement which indicates element to be extracted",

Accordingly, one skilled in the art -- but not having the benefit of hindsight -- would not find in Catapult and Jaakkola the motivation to combine steps (a) and (b) as claimed in claim 1. As such, the Patent and Trademark Office has not made out a *prima facia* case of obviousness under the provisions of 35 U.S.C. § 103.

Turning to claim 2, claim 2 is a more detailed recitation of claim 1 and as such, the above-mentioned arguments are also applicable to claim 2. More specifically, claim 2, compared to claim 1, further recites step (b) of acquiring an element edit statement into the document edit system and step (c) of defining an element search portion. Still further, claim 2 recites, at step (d), the details of step (b) of claim 1, viz., element match operations, ascertaining of matched element(s), extraction of the matched element, storing of the extracted element, and repetition of these operations until completing all the edit instructions in the element edit statement

The Examiner relies upon Catapult (pages 197-198) as in clam 1, Catapult (page 89), Microsoft Corporation (page 59), Jaakkola (page 1), and Hahn (pages 316-317), wherein especially the Examiner insists, referring to page 1 of Jaakkola, that:

> "[s]grep inherently involves implementing match operations
> between an element defined in said element edit statement and
> each of the elements in said element search portion, and
> ascertaining an element which matches the element defined in said
> element edit statement, the matched element being extracted if the
> matched element is indicated as being extracted ..."

However, the Examiner is not correct in his arguments because Jaakkola states on page 1 that <u>sgrep is a tool for searching text files and filtering text streams using structural criteria</u>. That is to say, Jaakkla completely fails to teach or suggest usage of "element", "element edit statement", and "matching of elements".

Again, one skilled in the art -- but not having the benefit of hindsight -- would not find in aforesaid citations the motivation to combine steps (a) to (d) as claimed in claim 2. As a result, the Patent and Trademark Office has again not made out a *prima facie* case of obviousness under the provisions of 35 U.S.C. § 103.

It is submitted that applicant's independent claims 1 and 2 are clearly patentable over the prior art. As such, applicant's dependent claims 3-18 are likewise deemed patentable since they incorporate all of the limitations of independent claim 2 from which they depend. The additional teachings of the secondary references do not cure the basic defects applicable to the independent claims as discussed above.
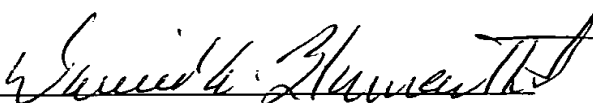
It is submitted that the application is now in condition for allowance and an early indication of same is earnestly solicited.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date <u>February 27, 2004</u>

By _____

FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5143
Telephone: (202) 672-5407
Facsimile: (202) 672-5399

David A. Blumenthal
Attorney for Applicant
Registration No. 26,257